

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

By the foregoing amendment, claims 1, 30, 80, 86, 92-93, 95, 99, 103, and 109 have been amended. No new matter has been added. Claims 2-18, 26-29, 45, and 56-79 were previously canceled. Thus, claims 1, 19-25, 30-44, 46-55, and 80-112 are currently pending in the application and subject to examination.

In the Office Action mailed December 19, 2002, under 35 U.S.C. § 103(a), the Examiner rejected claims 1, 19-25, 30-34, 46-50, 80, 81, 85, 91, and 102 as being unpatentable over U.S. Patent No. 5,557,722 to DeRose et al. ("DeRose"), claims 35-38 and 43-44 as being unpatentable over DeRose in view of U.S. Patent No. 5,241,671 to Reed et al. ("Reed"); claims 39-42, 51-62, 82-84, and 86-90 as being unpatentable over DeRose in view of U.S. Patent No. 5,204,947 to Bernstein et al. ("Bernstein"); and claims 53-55 as being unpatentable over DeRose in view of U.S. Patent No. 5,734,891 to Saigh ("Saigh"). It is noted that claims 1, 30, 80, 86, 92-93, 95, 99, 103, and 109 have been amended. To the extent that the rejections remain applicable to the claims currently pending, the Applicants hereby traverse the rejections as follows.

I. Claims 1, 30, 80, 86, 103, and 109

The Applicants' invention as now set forth in amended claim 1 is directed to an electronic book system including a first component of actual text of the electronic book, a second component, wherein the second component is a links menu to a plurality of additional components, wherein the first component is configured such that clicking on

the first component of actual text of the electronic book creates a link to the second component.

DeRose teaches a method for navigating an electronic book. DeRose is designed to assist users in navigating large electronic documents such as operation manuals for large systems. DeRose does teach a table of contents from which a section of a document may be selected. (See column 15, lines 43-45). The table of contents in DeRose appears to correspond to a second component which is a links menu. However, DeRose does not teach a first component that is a piece of actual text of the electronic book, that when clicked creates a link to the second component or is links menu, as recited in amended claim 1. DeRose shows in Figure 12, what appears to be a link to the table of contents. However, the link is not a piece of actual text of the electronic book, as recited in amended claim 1.

The present invention is designed to enhance electronic books by linking related material to the actual text of the electronic book. In contrast, DeRose is designed merely to assist with navigation of an electronic document.

Therefore, the Applicants submit that DeRose does not disclose or suggest a first component of actual text of the electronic book that is configured such that clicking on the first component creates a link to a second component or links menu to a plurality of additional components, as recited in amended claim 1.

For at least this reason, the Applicants submit that claim 1 is allowable over the cited art. For similar reasons, the Applicants submit that claims 30, 80, 103, and 109 are likewise allowable. As claim 1, 30, 80, 103, and 109 are allowable, claims 19-25, 31-44, 46-55, 81-85, 87-91, 102, 104-108, and 110, which depend from allowable claims 1,

30, 80, 86, 103, and 109, are therefore also allowable for at least this reason and for the additional subject matter recited therein.

II. Claims 92, 93, and 111

Applicants' invention as now set forth in claim 92 is directed to an electronic book system including links among components of digital data, wherein when the links are activated, a first component is linked to a second component; wherein the first component is located in the electronic book, and wherein the second component is located in a data repository at a distant operations center.

This allows a previously distributed electronic book to contain links to information that is continuously updated at an operations center. Thus, a book may contain enhanced features that are continuously current regardless of when the electronic book was received.

DeRose teaches annotations, such as bookmarks and corrections, for an electronic document that can be mailed to others. (See column 23, line 54-column 24, line 40). However, DeRose does not disclose or suggest a link connecting a first component located in the electronic book that connects to a second component located at a distant operations center. DeRose merely teaches that annotations can be shared and sent so that the annotation received by the other person is at the same location as the other person's electronic book.

For at least this reason, the Applicants submit that claim 92 is allowable over the cited art. For similar reasons, the Applicants submit that claims 93 and 111 are likewise allowable. As claims 93 and 111 are allowable, the Applicants submit that claims 94

and 112, which depend from allowable claims 93 and 111 are also allowable for at least the above noted reason and for the additional subject matter recited therein.

III. Claims 95 and 98

Applicants' invention as now set forth in claim 95 is directed to an electronic book system including links among a first component of digital data located in the electronic book and a second component located in a data repository, the data repository including a list of available books related to the first component.

This provides a powerful marketing tool through the link in the electronic book that leads to information regarding further, related electronic books which may be purchased, wherein the information regarding related books can be continually updated because the link in the original electronic book is connected to a distant data repository. Thus by merely updating the repository, all previously distributed electronic books are connected to current information.

DeRose teaches an electronic document that can be annotated to include bookmarks, history logs, corrections, etc. and wherein annotation lists can be sent to others. Each of these is described as a "navigational tool" and the invention of DeRose is directed to navigating the electronic document. Although these annotation lists can be sent to others, DeRose does not disclose or suggest a link between a component of the electronic book and a distant data repository, as recited in amended claim 95. DeRose does not disclose or suggest a system that would enable the marketing tool embodied in the present invention.

For at least this reason, the Applicants submit that claim 95 is allowable over the cited art. For similar reasons, the Applicants submit that claim 98 is likewise allowable.

As claim 95 is allowable, the Applicants submit that claims 96-97, which depend from allowable claim 95, are therefore also allowable for at least the above noted reason and for the additional subject matter recited therein.

IV. Claim 99

Applicants' invention as now set forth in claim 99 is directed to an electronic book distribution system, including a distant operation center, wherein the operation center is configured to store electronic books and corresponding links for those electronic books, wherein the operation center is configured to allow the selection and distribution of the links separate from the electronic book to which it corresponds.

This system enables the purchase and distribution of electronic books with the ability to select an additional feature of enhanced links that may be purchased for the electronic book, wherein the additional feature is a product separate from the electronic book.

DeRose merely teaches navigational tools for navigating a large electronic document. DeRose does not disclose or suggest a system for distributing electronic books and does not disclose or suggest a system for selling enhancing links to previously distributed electronic books. DeRose teaches that annotation lists may be shared, but specifically notes that the annotations need to be provided without modifying the documents. (See column 23, lines 62-67). In contrast, the claimed system purposefully modifies the electronic book upon the purchase of the enhancement.

Thus, the Applicants submit that DeRose does not disclose or suggest an electronic book distribution system including at least a distant operation center that stores electronic books and their corresponding links, wherein the operation center is

configured to allow the selection and distribution of the links separate from the electronic book to which it corresponds, as recited in amended claim 99.

For at least this reason, the Applicants submit that claim 99 as amended is allowable over the cited art. As claim 99 is allowable, the Applicants submit that claims 100-101, which depend from allowable claim 99, are therefore also allowable for at least the above noted reason and for the additional subject matter recited therein.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at pages 20-33. This is an insufficient showing of motivation.

CONCLUSION

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300 with reference to Attorney Docket No. 026880-00008.

Respectfully submitted,

Arent Fox PLLC


Sheree T. Rowe
Attorney for Applicants
Registration No. 59,068

Customer No. 004372
1050 Connecticut Ave., N.W., Suite 400
Washington, D.C. 20036-5339
Telephone No. (202) 715-8492
Facsimile No. (202) 638-4810